

DEC 20 2004

PATENT
Docket No. 49933US032IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): HOOPMAN et al.) Group Art Unit: 1722
Serial No.: 09/955,604) Examiner: Joseph S. Del Sole
Confirmation No.: 1214)
Filed: 19 September 2001)
For: TOOLS TO MANUFACTURE ABRASIVE ARTICLES

FACSIMILE TRANSMISSION TO THE PTO

Commissioner for Patents
Attn: Examiner Joseph S. Del Sole
P.O. Box 1450
Alexandria, VA 22313-1450

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Mueting, Raasch & Gebhardt, P.A.

20 DEC. 2004
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By: Kevin W. Raasch
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20 Dec. 2004
Date

Signature: Rachel Gebhardt-Gebhardt
Name: Rachel Gebhardt-Gebhardt

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RESPONSE

Commissioner for Patents
Mail Stop Amendment
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Office Action mailed 20 September 2004 has been received and reviewed. No claims having been amended or added, the pending claims are claims 23-24, 30-32, 89-90, 92-93, 134-136, 138-143, and 145-148. Reconsideration and withdrawal of the rejections are respectfully requested.

Obviousness-Type Double Patenting Rejection

Claims 23-24, 30-32, 89-90, 92-93, 134-136, 138-143, and 145-148 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17, 20-21, 25-28, 33-54, 94-96, and 98-111 of U.S. Patent Application No. 09/520,032. Upon an indication of otherwise allowable subject matter and in the event this rejection is maintained, Applicants will provide an appropriate response to this rejection.

Further, claims 23-24, 30-32, 89-90, 92-93, 134-136, 138-143, and 145-148 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,129,540. Upon an indication of otherwise

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allowable subject matter and in the event this rejection is maintained, Applicants will provide an appropriate response to this rejection.

The 35 U.S.C. §103(a) Rejections

The Examiner rejected claims 23-24, 30-32, 89-90, 92-93, 134-136, 138-143, and 145-148 under 35 U.S.C. §103(a) as being unpatentable over Pieper et al. (U.S. Patent No. 5,152,917) in view of Rochlis (U.S. Patent No. 3,312,583) and either Nelson et al. (U.S. Patent No. 5,273,558) or Calhoun (U.S. Patent No. 5,437,754). Applicants respectfully traverse this rejection.

The present application is a continuation application that, through a line of applications, is entitled to the benefit of a September 13, 1993 effective filing date. Among the references cited in support of this rejection, both Nelson et al. and Calhoun have publication dates after the effective filing date of the present application. Nelson et al. issued on December 28, 1993 (over three months after the effective filing date of the present application) while Calhoun issued on August 1, 1995 (almost two years after the effective filing date of the present application).

Furthermore, neither Nelson et al. nor Calhoun qualifies as prior art for an obviousness rejection under the provisions of 35 U.S.C. § 102(e). Title 35 U.S.C. § 103(c) provides that "subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

At the time the invention of the instant application was made, the claimed invention and the inventions of both Nelson et al. and Calhoun were owned by (or subject to an obligation of assignment to) the same entity.

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Accordingly, Applicants submit that the rejections under 35 U.S.C. § 103(a) are rendered moot because Nelson et al. and Calhoun are not prior art for obviousness purposes in view of 35 U.S.C. § 103(c). More specifically, because Nelson et al. and Calhoun qualify as prior art only under subsection (e) of 35 U.S.C. § 102, they must be excluded as prior art for obviousness purposes for the reasons set forth above.

In addition, Applicants expressly reserve the right to establish a date of invention for the claims subject to this rejection before the effective date of Pieper et al. at a later time.

For at least the above reasons, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of claims 23-24, 30-32, 89-90, 92-93, 134-136, 138-143, and 145-148 under 35 U.S.C. § 103(a) in view of the cited references. Applicants respectfully request reconsideration and withdrawal of the rejection.

Pending Claims

Applicants note the Examiner's request for a current set of claims. In view of the complicated and lengthy prosecution of the present application, Applicants have not prepared a set of claims as requested to avoid introducing additional complications into the present application. If further prosecution requires amendment of the claims, Applicants will, of course, comply with the requirements of 37 C.F.R. § 1.121.

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Summary

It is respectfully submitted that all the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
HOOPMAN et al.

By

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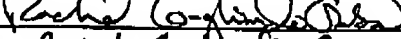
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Name: Rachel G. Gebhardt - Gebhardt